REMARKS

I.   Status of claims

Claims 1 and 3-20 are pending in this application. By this Amendment, claims 1 and 6

have been amended and claim 2 has been canceled. Reconsideration of the rejection is

respectfully requested in view of the above amendments and the following remarks.

II.   Claim Rejections

Claims 1-20 have been rejected under 35 U.S.C. §103(a) over U.S. Patent No. 7,395,239

to Riseman in view of U.S. Patent No. 5,870,721 to Norris. This rejection is respectfully

traversed.

Applicant notes that in order to establish a *prima facie* case of obviousness of a claimed

invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490

F.2d 981, 180 USPQ 580 (CCPA 1974). That is, "[a]ll words in a claim must be considered in

judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165

USPQ 494, 496 (CCPA 1970); *In re Edward S. Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994).

The combination of Riseman and Norris fails to disclose all of the features of pending

independent claims 1, 6, and 7.

Specifically, with respect to claim 1, Riseman and Norris fail to disclose (1) a web site

coupled to the network, the web site prompting the customer to enter the loan information,

receiving the loan information, and *merging the loan information with a loan application form*

to produce a loan application and *(2) the loan processor computing system performs the credit*

check by sending the loan application to a credit approval agency.

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With respect to (1), the Office Action references Riseman at Column 4, line 37 through Column 5, line 17 and Figure 1 to disclose this limitation. However, this section of Riseman fails to disclose merging the loan information with a loan application form to produce a loan application.

In the claimed invention, a loan application is created from the loan information so that the application can be forwarded both to a credit agency for approval and to a document server for creation of loan documents. However, in the system of Riseman, no documents are forwarded, rendering the merging of information to create a loan application unnecessary. No document server is included and furthermore, the computer running the Mortgage system software (MSS) 106 performs all of the processing steps, thereby eliminating the need for a loan application for forwarding. Accordingly, it is not necessary for Riseman to merge information from a form to create a loan application, since the MSS unilaterally evaluates the entered information. For example, as set forth in Column 5, lines 31-35, in step 204, the MSS automatically accesses and reviews data regarding the applicant's credit history. Further, in step 206, the MSS applies underwriting rules and in step 208, the MSS determines whether to approve the loan application. In Riseman, it appears that the entered information itself, as entered by the user comprises the "loan application". Thus Riseman also fails to disclose (2) the loan processor computing system performs the credit check by sending the loan application to a credit approval agency, since Riseman at most collects information from a credit agency, but does not send a credit application to another entity for approval.

Norris fails to obviate the above mentioned deficiencies of Riseman. Thus, even if combined, Riseman and Norris would not have resulted in the invention of claim 1. Accordingly, a *prima facie* case of obviousness cannot be established. Specifically, before

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considering what would be obvious to one of ordinary skill in the art at the time of the invention,

the art must teach or suggest the claim limitations. See MPEP §2143.

Furthermore, no motivation would have existed to modify Riseman with the disclosure of

Norris. Riseman is directed to Mortgage System Software, whereas Norris is directed to general

loan application processing.

As acknowledged in the Office Action, the system of Riseman additionally lacks the

claimed document server coupled to the loan processor. The document server generates and

sends the loan document to the customer, based on the loan application. When the loan

processor determines that the customer should receive the loan, the loan processor sends the loan

document to the customer through one of email, facsimile, the network, a first printer coupled to

the network, and a second printer coupled to another network.

The secondary reference, Norris, is directed to a system and method for loan approval.

The system is directed towards enabling a customer to access a kiosk having a voice

communication processor that allows the customer to provide verbal information relevant to the

loan process. Because Norris discloses faxing the loan agreement to the customer, the Office

Action alleges that it would have been obvious to include this feature in the system of Riseman

in the form of a document server for speedy transmittal.

However, this scenario is extremely unlikely. The system of Riseman is related

exclusively to mortgages. In general, mortgage documents are delivered in person to loan

recipients in accordance with existing state regulations that require mortgages to be closed in

person. Thus, there would have been no point in expediting delivery of these documents, which

were not at the time of the invention, and still are not today, delivered to mortgage loan recipients prior to the actual closing.

Thus, the combination of the teaching of Riseman and Norris is insufficient to establish a *prima facie* case of obviousness against claim 1 because the combination of references fails to disclose each claimed feature and because no motivation would have existed to combine the references.

Independent claim 6 sets forth similar limitations to those set forth above with respect to claim 1 in method form and therefore defines over the art of record for reasons parallel to those set forth above with respect to claim 1. Specifically, claim 6 requires receiving loan information from the customer over a network by a web site hosted by a loan approval system computer and merging, at the loan approval system computer, the loan information with a loan application form to produce a loan application. Claim 6 further requires performing a credit check on the customer based upon the loan application and determining at the loan approval system computer whether the customer should receive the loan based on the credit check, wherein the loan processor computing system performs the credit check by sending the loan application to a credit approval agency. Claim 6 further requires, upon customer approval, generation and sending of a loan document associated with the loan and based on the loan application, wherein the document is created at a loan document creation server connected with the loan approval system computer and the loan document creation server includes a forms database for producing loan documents related to an approved loan application, the sending being through one of e-mail, facsimile, the network, a first printer coupled to the network, and a second printed coupled to another network.

The combination of Riseman and Norris fails to disclose these features and therefore a *prima facie* case of obviousness has not been established. For instance, in addition to the

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features set forth above with respect to claim 1, Riseman and Norris fail to disclose generation

and sending of a loan document associated with the loan and based on the loan application,

wherein the document is created at a loan document creation server connected with the loan

approval system computer and the loan document creation server includes a forms database for

producing loan documents related to an approved loan application.

Claim 7 defines a method for creating a loan contract between a customer and a bank, the

loan contract including terms where the bank loans money to the customer, and terms where the

customer is obligated to pay the money back to the bank. The method involves the bank

receiving loan information from the customer at a web site hosted by a loan approval system

computer and merging, at the loan approval system computer, the loan information with a loan

application form to produce a loan application, the loan information indicating the terms. The

method additionally includes the bank processing the loan information at the loan approval

system computer to determine whether the bank desires to enter into the loan contract, the

processing including automatically requesting and evaluating a credit report through the loan

approval system computer. If the bank desires to enter into a loan contract based on evaluation

of the credit report through the loan approval system computer, the bank generates a loan

document by accessing a loan document creation server connected with the loan approval

system computer and sends the loan document to the customer, the loan document being based

on a loan application and associated with the loan contract and listing the terms. *The method*

further includes sending a check to the customer, the check corresponding to the loan contract.

thereafter, the customer performing the steps of receiving the loan document; receiving the

check; and negotiating or cashing the check; whereby cashing the check indicates acceptance by

the customer of the terms listed in the loan document.

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With regard to claim 7, with respect to this final limitation, Riseman discloses a mortgage

loan system. This limitations italicized above simply cannot exist for a mortgage loan, based on

existing regulations. Accordingly, regardless of whether these steps were known in the art, it

would not have been obvious to modify Riseman by implementing them. Mortgages involve a

rescission period and acceptance hinges on the expiration of the rescission period and not on the

cashing of a check. Furthermore, as set forth above with respect to claim 1, the references lack

merging, at the loan approval system computer, the loan information with a loan application

form to produce a loan application.

As set forth above, even if combined, Riseman and Norris fail to disclose each and every

claimed feature. Accordingly, the Office Action does not establish a *prima facie* case of

obviousness. Specifically, before considering what would be obvious to one of ordinary skill in

the art at the time of the invention, the art must teach or suggest the claim limitations. See

MPEP §2143.

Thus, the combination of the teaching of Riseman and Norris is insufficient to establish a

prima facie case of obviousness against claim 1, 6, and 7 because the combination of references

fails to disclose each claimed feature and because no motivation would have existed to combine

the references.

The Office Action fails to establish a *prima facie* case of obviousness that the pending

claims are unpatentable. "During patent examination, the PTO bears the initial burden of

presenting a *prima facie* case of unpatentability." *In re Glaug*, 283 F.3d 1135, 62 U.S.P.Q.2d

1151, 1152 (Fed. Cir. 2002). "If the PTO fails to meet this burden, the applicant is entitled to the

patent." Id. "To support the conclusion that the claimed combination is directed to obvious

subject matter, either the references must expressly or impliedly suggest the claimed

combination or the Examiner must present a convincing line of reasoning as to why the artisan

would have found the claimed invention to have been obvious in light of the teachings of the

references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int.. 1985). The

references applied in the Office Action fail to suggest the claimed invention for at least the

reasons set forth with regard to each claim below. An artisan of ordinary skill would not have

found the claimed invention to have been obvious in light of the teaching of the applied

references. As the Examiner has not presented a *prima facie* case of unpatentability, applicant is

entitled to a patent.

Claims 3-5 depend from claim 1, and define over the art of record for at least the reasons

set forth above with respect to claim 1. Claims 8-20 depend from claims 1, 6, and 7 and

therefore define over the art of record for at least the reasons set forth above with respect to

claims 1, 6, and 7. Accordingly, withdrawal of the rejection of claims 1-20 under 35 U.S.C.

§103 is respectfully requested.

III.   Conclusion

As set forth above, applicants respectfully submit that all claims are in condition for

allowance. Withdrawal of all rejections and prompt passage to issuance are earnestly requested.

In the event Applicants have overlooked the need for an extension of time, payment of fee, or

additional payment of fee, Applicants hereby petition therefore and authorize that any charges be

made to Deposit Account No. 50-4494.

Should the Examiner have any questions regarding any of the above, the Examiner is respectfully requested to telephone the undersigned at 202-346-4016.

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Respectfully submitted,

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